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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO.       |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/538,012   | 09/07/2006  | David Skuse          | 07812.0059-00                 | 6868                   |
| 22852 7590 11/26/2007<br>FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | EXAMINER<br>ABU ALI, SHUANGYI |                        |
|  |             |                      | ART UNIT<br>1793              | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>11/26/2007       | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/538,012 | <b>Applicant(s)</b><br>SKUSE ET AL. |  |
|                              | <b>Examiner</b><br>Shuangyi Abu-Ali  | <b>Art Unit</b><br>1793             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

(1)

***Status of Claims***

Claims 1-53 remain for examination .

(2)

***Claim Rejections - 35 USC § 102***

Claims 1, 5-17, 19-33, 35-43 and 47-53 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/66510 to Lyons et al. as general set forth in the first office action mailed on 05/09/2007 stands.

***Claim Rejections - 35 USC § 103***

Claims 2-4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/66510 to Lyons et al., in view of U.S. Patent NO. 5,879,442 to Nishiguchi et al. as general set forth in the first office action 05/09/2007stands.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/66510 to Lyons et al., in view of U.S. Patent Application Publication No. US 2005/0126730 to Lorusso. as generally set forth in the first office action 05/09/2007stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

***Response to Arguments***

Applicant's arguments filed 08/31/2007 and 10/03/2007 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-53 as indicated in the first office action stand.

First, Applicant argues that Lyons et al. do not anticipate the claims 1, 5-17, 19-33, 35-43 and 47-53. The Examiner respectfully submits that Lyons et al. disclose a composition comprising ground calcium carbonate (GCC) particles and precipitated calcium carbonate (PCC) particles ( page 5, lines 14-16).The calcium carbonates particles have a steepness factor larger than 38 for GCC and 50 for PCC. The median particle size of both calcium carbonates is less than 0.8 um (page 5, lines 14-16, page 8, lines 15-17 and page 9, line 5). And The Examiner respectfully submits that **"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.** Furthermore, unexpected result cannot be used to overcome 35 U. S. C. 102 rejections.

Second, Applicant argues that there is no motivation for the combination of Lyons in view of Nishiguchi. The Examiner respectfully submits that Nishiguchi et al. also drawn to paper coating composition disclose a coating composition having a GCC amount to PCC amount ratio in the range of 49:51 to 30:70 (col. 4, line 62). Furthermore, Nishiguchi et al. disclose that the selection of the amount ratio of GCC to PCC is depended on the intended use and the above ratio range renders high content carbonates slurry and the coated paper has good printability and glossiness (col. 2 lines 23-28 and col. 1 line, 10-20).

Third, Applicant argues that there is no motivation for the combination of Lyons in view of Lorusso. The Examiner respectfully submits that Lorusso, also drawn to composition for paper disclose that a composition comprising calcium carbonate particles and kaolin particles with a shape factor larger than 60 is suitable for paper filler ([0011] and [0001]). As for the allegation of teaching away of Lyons, the Examiner respectfully submits that the Lyons discloses that the kaolin may have a low shape factor, but not must have a low shape factor.

(4)

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SA

  
J.A. LORENGO  
SUPERVISORY PATENT EXAMINER